

REMARKS

I. Summary of Restriction Requirement and Status of Application

This paper is responsive to the Office Action mailed on April 28, 2004 having a one-month shortened statutory period of response. Reconsideration of the restriction is respectfully requested. Claims 1-39 are currently pending in this application. Claims 1-23, 26-34, 36, and 38 are original. Claims 24, 25, 35, and 37 are currently amended. Claim 39 is new. No new matter is added.

II. Provisional Election with Traverse

Applicant hereby provisionally elects Group I for prosecution with traverse, pursuant to Rule 1.143.

The restriction is traversed for the following reasons: (1) the Examiner does not provide reasonable examples that recite material differences; (2) the Examiner does not provide a prima facie case to support the serious burden criterion for restriction; and (3) the application, as amended, includes a linking claim, thereby rendering the restriction improper.

Regarding (1) above, the Examiner cites MPEP § 806.05(e) with respect to Group I and Group II, which states that inventions are distinct if it "can be shown: (A) the process as claimed can be practiced by another materially different apparatus or by hand; or (B) that the apparatus as claimed can be used to practice another and materially different process." The Office Action indicates that the former of these two conditions (i.e., "(A)") is applicable to the present application.

Page 2 of the Office Action asserts that "the process as claimed can be practiced by another materially different apparatus such as one in which the human interface can be substituted for the computer medium in the chemical mechanical polishing (CMP) process." It is not clear, however, that a "human interface" could reasonably adjust the operating parameters of the conditioning disk as a functional replacement of the computer medium. A human interface would not be able to perform the necessary calculations with any degree of accuracy in real time. Accordingly, the Examiner has not shown that the process as claimed can be practiced by hand, or otherwise.

MPEP §806.05(e) states that “the burden is on the examiner to provide reasonable examples that recite material differences.” The Office Action provides no reasonable examples that recite material differences. In addition, the Office Action provides no basis for the restriction requirement of Group III, and the restriction is, therefore, improper.

Regarding (2) above, the Restriction Requirement cited class/subclass combinations to search:

Group I: 438/689

Group II: 216/52

Group III: 703/7

MPEP §808.02 states “the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation...each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search.” The Office Action offers no such explanation and is silent with respect to separate searches for each Group. As such, “a serious burden on the Examiner” has not been demonstrated, as required by MPEP §803.

Lastly, regarding (3) above, Applicant submits herewith an Amendment, including a linking claim (new claim 39) that comports with the requirements of MPEP § 806.05(e) which overcomes the requirement for restriction.

III. Conclusion

For the reasons given above, the Examiner is respectfully requested to reconsider and withdraw the restriction requirement. Questions or issues arising in this matter should be directed to Applicant’s representatives, listed below.

The Commissioner is hereby authorized to charge the required fees of \$524 to Deposit Account No. 50-1074 for the two month extension of time, the additional independent claim, and claim in excess of twenty. No other fees are believed to be required. However, the Commissioner is hereby authorized to charge any additional fees should any be required for this submission, or credit any overpayment to Deposit Account No. 50-1074.

Appl. No. : 09/998,384
Response Dated : July 8, 2004
Reply to Office Action of : April 28, 2004

Atty. Docket No. 5916/FET/FET/DV

Respectfully submitted,

Date: _____

July 8, 2004

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